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benzylsulfonylmethyl)-N-[1-(5-ethyl[1,3,4]oxadiazole-2-carbonyl)butyl]-4-morpholin-4-yl-4-oxobutyramide which is a compound of Formula I wherein:

$X^1$  is  $-C(R^1)(R^2)X^2$ , wherein  $R^1$  is hydrogen,  $R^2$  is  $(C_{1-6})$ alkyl and  $X^2$  is  $-C(R^7)(R^8)R^5$ , wherein  $R^7$  and  $R^8$  together form oxo, and  $R^5$  is hetero( $C_{4-10}$ )aryl( $C_{0-6}$ )alkyl substituted further with  $(C_{1-6})$ alkyl, namely 5-ethyl[1,3,4]oxadiazol-2-yl;

$R^3$  is  $-C(R^{16})(R^{17})X^7$  wherein  $R^{16}$  and  $R^{17}$  are each hydrogen and  $X^7$  is  $-X^4S(O)_2R^{15}$ , wherein  $X^4$  is bond and  $R^{15}$  is  $(C_{6-10})$ aryl( $C_{0-6}$ )alkyl substituted further with  $X^4OR^{13}$  wherein  $X^4$  is bond and  $R^{13}$  is halo-substituted  $(C_{1-6})$ alkyl, namely 2-difluoromethoxyphenyl; and

$R^4$  is  $-C(R^{16})(R^{17})X^7$  wherein  $R^{16}$  and  $R^{17}$  are each hydrogen, and  $X^7$  is  $-X^4C(O)R^{15}$ , wherein  $X^4$  is bond and  $R^{15}$  is hetero( $C_{3-10}$ )cycloalkyl( $C_{0-3}$ )alkyl, namely morpholin-4-yl. The Applicants traverse Restriction Requirement II for the following reasons.

## REMARKS

The Examiner relies upon *In re Harnish* and *Ex parte Hozumi* to support Restriction Requirement II. The Examiner misconstrues both decisions. *In re Harnish* and *Ex parte Hozumi* have nothing to do with restriction practice. *In re Harnish* and *Ex parte Hozumi* are about “[t]he judicially created rejection of claims for improper Markush grouping. An improper Markush group rejection may be made only after an examination on the merits and an explanation has been set forth why, in the case at hand, the breadth represented by the variables within the claim derogate from unity of invention. In contrast, a restriction requirement takes place prior to examination on the merits. The criteria for making an improper Markush group rejection are not interchangeable with those for making a restriction requirement. The Examiner misapplies the holdings of *In re Harnish* and *Ex parte Hozumi* to support Restriction Requirement II.

*In re Hass* and *In re Weber* represent the controlling case law for restriction practice. The Examiner has gone to great lengths to describe how the compounds encompassed by Groups I-XII are patentably distinct. However, the Examiner has not offered any explanation as to why, in this instance, the holdings of *In re Hass* and *In re Weber* may be disregarded. *In re Hass* and *In re Weber* unambiguously ruled that §121 could not be used as the basis for rejecting a single claim or compelling its replacement by a plurality of narrower claims. Accordingly, there is never any

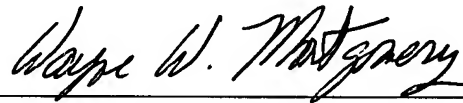
circumstance where it is proper to use 35 U.S.C. §121 to parcel an Applicant's invention into separate claims. The Applicants have provided herewith copies of *In re Harnish*, *Ex parte Hozumi*, *In re Hass* and *In re Weber* with relevant passages highlighted for the sake of convenience.

### CONCLUSION

In light of the above remarks and those made in the September 10, 2003 response in traverse of Restriction Requirement I, the Applicants request that their generically claimed invention be examined in its entirety and that, in the absence a statutory or judicially created basis for forming a rejection, Claims 1-29 and 31 be allowed.

Respectfully submitted

Date: March 24, 2004



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CFR §1.141 deals explicitly with "independent and distinct inventions"<sup>4</sup>, even permitting five of them to be patented on one application along with a generic claim. As to species in excess of five specifically claimed, it is implicit that they may still fall within the "coverage" of the generic claim even if separately patented. It is elementary patent law that the number of "species" "covered" by a patent having a generic claim is virtually without limit notwithstanding the limitation of Rule 141 to five species "specifically claimed." So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim — no matter how broad, which means no matter how many independently patentable inventions may fall within it.

Of course a broad claim may be unpatentable for any number of reasons, but we are not here dealing with a question of patentability under the statute but with a refusal to examine.

The only basis here claimed in support of the labels "improper" and "misjoinder" is the scope of the claim. That is not sufficient excuse.

As for the true meaning of the words "two or more independent and distinct inventions are claimed" in §121, being based — as they were — on the "division" practice existing in the then Patent Office in 1952, there can be no doubt they refer to separate inventions separately claimed and to a requirement to put separate claims in separate applications or at least to restrict one application to one claimed invention. There is no indication that enactment of §121 contemplated refusing examination to generic claims because of their scope or that applicants were to be denied the right to present single claims of any breadth they chose and have them examined.

The PTO effort of the past few years to justify its refusal to examine by issuing a "rejection" pursuant to the May 1, 1974, notice (MPEP 803) on the basis of §121 is mere semantic gamesmanship.

With respect to the remand to consider the "improper Markush" rejection of claims 1-6, it is my view, based on careful analysis of the rejections actually made,

<sup>4</sup> Note Rule 141's wording: "Two or more independent and distinct inventions may not be claimed in one application, *except* \* \* \*." (My emphasis.) Compare the wording of 35 USC 121.

that the PTO, following the May 1, 1974, notice (922 OG 1016), created a new kind of "improper Markush" rejection based on 35 USC 121 which we are reversing. There remains, however, a vast body of precedent antedating the 1974 notice on what proper "Markush" claims are. As I understand the majority's remand, it is for the purpose of examining claims 1-6 under the pre-notice law relating to Markush practice in the process of examining these claims on their merits. Until now, such examination has been refused because they "cover" or "embrace" too much, a basis of rejection we find impermissible.

### Court of Customs and Patent Appeals

In re Haas

No. 78-536

Decided June 30, 1978

### PATENTS

#### 1. Court of Customs and Patent Appeals — Issues determined — Ex parte patent cases (§28.203)

There is no issue before Court of Customs and Patent Appeals that claims are drawn to improper Markush groups where there is no rejection on that ground.

#### 2. Applications for patent — Divisional (§15.5)

##### Claims — Miscellaneous objections (§20.70)

##### Joinder of invention — In general (§42.01)

##### Pleading and practice in Patent Office — Rejections (§54.7)

Section 121 does not provide basis for rejection of claim.

##### Particular patents — Polymerization

Haas, Novel Polymerization Initiators, rejection of claim 7 and 8, reversed and remanded.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Howard C. Haas, Serial No. 821,511, filed May 2, 1969 continuation-in-part of application, Serial No. 630,222 filed Apr. 12, 1967. From decision rejecting claims 7 and 8, applicant appeals. Reversed and remanded.

See also 1 and 188 US Stanley H. for appel Charles A. F. Jorda, Wegner, Tyner, A Westlake, sel) for a Joseph F. N of coun Patents a Before Mar Baldwin, Judges. Markey,

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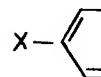
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## Patent Appeals

June 30, 1978

## Patent Appeals 1 — Ex parte

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## Trademark Of

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filed May 2,  
of application  
Apr. 12, 1967  
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and remanded.

See also 175 USPQ 217, 179 USPQ 623, and 188 USPQ 374.

Stanley H. Mervis, Cambridge, Mass., for appellant.

Charles A. Wendel, Arlington, Va., Karl F. Jorda, Ardsley, N.Y., and Harold C. Wegner, Washington, D.C. (Earl L. Tyner, Arlington, Va., and Harry E. Westlake, Jr., Rahway, N.J., of counsel) for amicus curiae.

Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

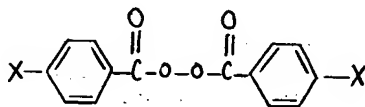
Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Markey, Chief Judge.

This appeal is from a decision of the United States Patent and Trademark Office (PTO) Board of Appeals (board) affirming a final rejection under 35 USC 121 of claims 7 and 8 of application serial No. 821,511, filed May 2, 1969, entitled "Novel Polymerization Initiators."<sup>1</sup> We reverse and remand.

## Invention

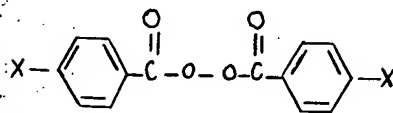
The invention is a group of benzoyl peroxides:



useful as initiators for polymerization of vinyl-containing compounds or monomers. Haas states: "The substituent X does not participate in the polymerization initiation, but it does introduce into the resulting polymer a reactive, terminal group at one or both ends of the resulting polymer chain. Thus, while the resulting polymers may have different utilities, all of the claimed compounds have the same utility [i.e., polymerization initiators]."

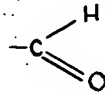
Claims 7 and 8 are the sole claims on appeal:

7. A compound of the formula

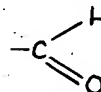


8. A continuation-in-part of serial No. 630,222, filed April 12, 1967.

wherein X is selected from the group consisting of  $\alpha$ -monosubstituted chloro, bromo and fluoro alkyl groups containing from 1-3 carbon atoms, inclusive; and



8. The invention of claim 7 wherein X is selected from the group consisting of  $\alpha$ -monosubstituted chloro alkyl groups containing from 1-3 carbon atoms, inclusive; and



## Background

Haas comes before this court for the second time on the present application. In *In re Haas*, 486 F.2d 1053, 179 USPQ 623 (CCPA 1973) (Haas I), the examiner held claims 1 and 2 withdrawn from further consideration under 35 USC 121 as drawn to "multiple patentable [sic, patentably] distinct inventions."<sup>2</sup> This court held that "withdrawal" of a claim from consideration, under those circumstances, constituted a rejection reviewable by the board under 35 USC 7 and 134, and by this court under 35 USC 141. The decision of the board to dismiss for lack of jurisdiction was reversed, and the case was remanded for further action consistent with the opinion.

The board remanded the case to the examiner. The examiner rejected claims 1 and 2 "as improper Markush claims and for misjoinder [of invention] under 35 USC 121" because drawn to multiple "independent and distinct" inventions. Though initially arguing that claims 1 and 2 did not define "independent and distinct" inventions, Haas expressly abandoned that argument on appeal to the board and conceded "that his recited Markush group contains 'multiple independent and distinct inventions' in the same sense that a generic term may contain multiple independent and distinct inventions." In view of that concession, the board stated: "[T]he only question presented by this appeal is whether or not a single claim which includes a plurality of independent and distinct inventions is legally rejectable."<sup>3</sup> The board answered affirmatively.

<sup>2</sup> Claim 2 was dependent from claim 1 and limited substituent X to the para position of the benzene rings. The "independent and distinct" inventions were thus alleged to fall within claim 1 alone or claims 1 and 2 taken together.

<sup>3</sup> Ex parte Haas, 188 USPQ 374, 376 (PTO



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The examiner's rejection of claims 7 and 8 herein as "improper Markush" claims is inextricably intertwined on this record with the application of §121. The solicitor's brief states that the examiner is willing to examine claims 7 and 8 as a whole on their merits.

Accordingly, the decision of the board is reversed and the case is remanded for examination of claims 7 and 8 on their merits.

*Reversed and Remanded*

### Court of Customs and Patent Appeals

In re The Clorox Company

No. 77-628

Decided June 30, 1978

### TRADEMARKS

#### 1. Registration — In general (§67.731)

##### Registration — Supplemental Register (§67.765)

Examiner of Trademarks and Patent and Trademark Office Trademark Trial and Appeal Board are charged, under Lanham Act Section 2(d), with duty of refusing registration of mark, whose use is likely to cause confusion because of its resemblance to mark registered in Patent and Trademark Office; Lanham Act Section 23 indicates that Supplemental Register is continuation of register provided in paragraph (b) of Section 1 of Act of March 19, 1920; Section 2(d)'s absence from enumeration of statutory provisions made inapplicable to Supplemental Register establishes unequivocally its applicability to registrations on Supplemental Register.

#### 2. Identity and similarity — In general (§67.401)

##### Identity and similarity — How determined — In general (§67.4051)

##### Registration — In general (§67.731)

Protection envisaged by Trademark Act Section 2(d) is not that of marks against mere registration of other marks, hence conflict must occur in marketplace; refusal to register conflicting mark does not protect registered mark against use of con-

flicting mark in marketplace; users of trademarks and owners of registrations, when they seek protection of their marks, are necessarily protecting their right to unconfused public, and are serving statutory goal of protecting public against confusion; sole duty of Trademark Examiner, Trademark Trial and Appeal Board, and Court of Customs and Patent Appeals, under Trademark Act Section 2(d), is to determine whether confusion is likely; confusion sought to be prevented by Trademark Act is not that of examiners, lawyers, board members, or judges; confusion is likely, if at all, only in marketplace where marks are used; registration is itself incapable of causing confusion; Patent and Trademark Office is not charged under Trademark Act Section 2(d) with duty of permitting or denying right to use any mark, or of protecting any registered mark against mere registration of similar marks, unless use of latter would be likely to cause confusion.

#### 3. Identity and similarity — How determined — In general (§67.4051)

##### Registration — Supplemental Register (§67.765)

##### Statutes and treaties (§67.80)

Mark registered on Supplemental Register can be used as basis for refusing registration to another mark under Trademark Act Section 2(d); resort to legislative history is unnecessary where Trademark Act language is clear and unambiguous.

#### 4. Cancellation — In general (§67.171)

##### Registration — Supplemental Register (§67.765)

Marks registered on Supplemental Register are required to be capable of distinguishing applicant's goods or services under Trademark Act Section 23; party has cancellation proceeding available under 15 U.S.C. 1092 if registrant was not entitled to registration, on grounds that mark is common descriptive term and thus incapable of indicating origin of goods, or because mark is not used by registrant or has been abandoned.



**Court of Customs and Patent Appeals**

In re Weber, Soder, and Boksay

No. 77-622, Decided June 30, 1978

**PATENTS****1. Court of Customs and Patent Appeals — Jurisdiction (§28.25)**

Court of Customs and Patent Appeals has jurisdiction over "improper Markush claims" rejection and Section 121 rejections.

**2. Claims — Broad or narrow — In general (§20.201)**

Applicant is given, by statute, right to claim his invention, with limitations he regards as necessary to circumscribe invention, with proviso that application comply with requirements of Section 112.

**3. Applications for patent — Divisional (§15.5)****Joinder of invention — In general (§42.01)**

Applicant has right to have each claim examined on merits, as general proposition; it may well be that pursuant to proper restriction requirement that number of claims submitted in one application will be dispersed to number of applications; such action would not affect right of applicant eventually to have each of claims examined in form he considers to best define his invention; however, single claim that is required to be divided up and presented in several applications would never be considered on its merits; totality of resulting fragmentary claims would not necessarily be equivalent of original claim; further, it is not inconceivable that number of fragments would not be described in specification, since subgenera would be defined by examiner rather than by applicant.

**4. Applications for patent — Divisional (§15.5)****Commissioner of Patents — In general (§21.01)****Joinder of invention — In general (§42.01)****Pleading and practice in Patent Office — Rejections (§54.7)**

Section 121 provides Commissioner of Patents and Trademarks with authority to promulgate rules designed to restrict application to one of several claimed inven-

tions when those inventions are found to be "independent and distinct"; however, it does not provide basis for examiner acting under Commissioner's authority to reject particular claim on that same basis.

**5. Applications for patent — Divisional (§15.5)****Claims — Broad or narrow — Markush type — In general (§20.2051)****Commissioner of Patents — In general (§21.01)****Joinder of invention — In general (§42.01)****Pleading and practice in Patent Office — Rejections (§54.7)**

Patent Office must have some means for controlling such administrative matters as examiner caseloads and amount of searching done per filing fee, even though statute allows applicant to claim his invention as he sees fit; Commissioner of Patents has authority to "establish charges for \* \* \* services furnished by the Patent and Trademark Office," under 35 U.S.C. 41(b); statutory rights are paramount in drawing priorities between Commissioner as administrator and applicant as beneficiary of his statutory rights; rejection of claims under Section 121 violates basic right of applicant to claim his invention as he chooses.

**6. Joinder of invention — In general (§42.01)****Pleading and practice in Patent Office — Rejections (§54.7)**

Restriction requirement and subsequent action of examiner in withdrawing nonelected claims from consideration does not, per se, constitute rejection; however, In re Haas, 179 USPQ 623, in which examiner's action in withdrawing claims was rejection, since "claims were withdrawn from consideration not only in this application but prospectively in any subsequent application because of their content," is exception.

**Particular patents — Diamine Derivatives**

Weber, Soder, and Boksay, *Cyclic Diamine Derivatives*, rejection of claims 1-6, 16, 17, 20, and 22 reversed and remanded; appeal of claims 8-13, and 23 dismissed.

Appeal from Patent and Trademark Office Board of Appeals.

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#### — Diamine Deriva-

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#### t and Trademark Of-

Application for patent of Rolf-Ortwin Weber, Alfons Soder, and Istuan Boksay, Serial No. 307,406, filed Nov. 11, 1972. From decision rejecting claims 1-6, and dismissing appeal as to claims 8-13, 16, 17, 20, 22, and 23, applicants appeal. Reversed and remanded; Rich, Judge, concurring with opinion.

David R. Murphy, Arlington, Va., for appellants.

Charles A. Wendel, Arlington, Va., and Harold C. Wegner, Washington, D.C., for Patent, Trademark, and Copyright Section, Virginia State Bar, amicus curiae.

Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Baldwin, Judge.

This appeal is from a decision of the United States Patent and Trademark Office (PTO) Board of Appeals (board) affirming the examiner's rejection of claims 1-6 "as being improper Markush claims<sup>1</sup> and misjoinder under 35 USC 121."<sup>2</sup>

The board also dismissed, for want of jurisdiction, the appeal of claims 8-13, 16, 17, 20, 22 and 23 in that the claims "were withdrawn from consideration since they were directed to non-elected inventions." We reverse and remand.

#### Invention

The invention relates to cyclic diamine derivatives which possess the common property of psychotherapeutic effective-

<sup>1</sup> Section 706.03(y) (note 4, *infra*) of the Manual of Patent Examining Procedure (MPEP) provides guidance in the use of Markush format and is cited by the examiner in his Answer before the board. MPEP 803 (note 3, *infra*), which applies 35 USC 121 to Markush claims, is also cited by the examiner in his final office action.

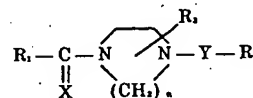
<sup>2</sup> Section 121 provides, in pertinent part:

#### Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application.

ness. The derivatives are identified by a single generic formula expressed in Markush format in representative claim 1:

1. A compound having the general formula



or an acid addition salt thereof in which formula  $R_1$  is selected from the group consisting of

- A) an at least mononuclear heterocyclic group having 4 to 10 carbon atoms in the ring system bound to the group  $-C-N$  through a carbon atom and

X containing at least one oxygen, nitrogen or sulphur atom,

- B) substitution products of A) containing at least one substituent selected from the group consisting of halogen, trifluoromethyl, hydroxy, alkoxy of 1 to 3 carbon atoms, unsubstituted amino, amino substituted by up to two alkyl groups each having 1 to 3 carbon atoms and alkyl groups having 1 to 6 carbon atoms,

X is oxygen, sulphur or an NH-group, Y is an alkylene group having 1 to 3 carbon atoms in the chain, or an alkylene group having 1 to 3 carbon atoms in the chain substituted by a) up to 3 alkyl groups each having up to 3 carbon atoms and a total of not more than 8 carbon atoms, or b) substituted by one or two phenyl groups,

$R_2$  is selected from the group consisting of

- C) an at least mononuclear carbocyclic or heterocyclic group having 4 to 10 carbon atoms in the ring system, containing but one heteroatom in a ring,

D) substitution products of C) containing at least one substituent selected from the group consisting of nitro, halogen, trifluoromethyl, alkyl having 1 to 6 carbon atoms, hydroxy, alkoxy having 1 to 3 carbon atoms, unsubstituted amino groups and amino groups substituted by up to two alkyl groups each having 1-3 carbon atoms,

$R_3$  is hydrogen or up to two substituents selected from alkyl groups having up to 2 carbon atoms and phenyl groups;

n is 2 or 3.

### Background

In the first office action dated January 17, 1974, the examiner "objected" to claims 1-6, 8-13 and 23 and required applicants to elect one of three groups of claims: group I (claims 7 and 14-22), group II (claims 8-13); or group III (claim 23). Applicants elected, with traverse, group I and brought to the examiner's attention his failure to include claims 1-6 in the groups. The status of claims 1-6 was clarified in the second and final action, dated December 26, 1974, in which those claims were "rejected." The examiner also stated that claim 1 embraced 24 enumerated independent and distinct inventions. The examiner, in conclusion, stated that:

Markush claims 1 to 6 are rejected as being improper Markush claims and for misjoinder under 35 U.S.C. 121. (922 O.G. 1016, 4th and 6th paragraph).<sup>3</sup>

<sup>3</sup> The examiner exercised his discretion under 922 O.G. 1016 which was a notice issued by the Commissioner on May 1, 1974; (now MPEP 803) which provides in part:

A Markush-type claim is directed to "independent and distinct inventions," if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s).

[Paragraph 4.]

If the claim is of that nature, the examiner is authorized to reject it as an improper Markush claim and for misjoinder under 35 U.S.C. 121 and to require the applicant to restrict the application to a single invention. In making such a requirement, the examiner will (1) clearly delineate the members or groups of members believed to constitute improperly joined inventions, and (2) state reasons fully explaining why they are independent and distinct. Applicant's response to such a requirement should be an election of a single adequately disclosed and supported invention, with or without restriction of the claim(s) to that invention. Of course, the response must not introduce new matter into the application. See 35 U.S.C. 132 and *In re Welstead*, 59 CCPA 1105, 463 F.2d 1110, 174 USPQ 449 (1972). A refusal to elect a single invention will be treated as a non-responsive reply.

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner is encouraged to examine it on the merits, even though it is directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure outlined in the preceding paragraph

In his Answer, the examiner expanded upon the basis of the rejection. He discussed MPEP 803, in particular the phrase "independent and distinct" of §121 and applied the phrase to the claims. Continuing, the examiner discussed the Markush claims and stated:

The compounds embraced do not have a common nucleus and are improperly Markushed under the criteria set forth in M.P.E.P. 706.03(y) \* \* \*  
\* \* \* The specification discloses that certain compounds have activities not shared by all of the scope claimed \* \* \*.

and will not require restriction.

[Paragraph 6.]

Where the examiner has rejected the claim and required restriction and the applicant has responded without restricting the claim(s) to a single invention, the examiner shall, if the position is adhered to, again reject the claim and any other Markush claims not restricted to the elected invention. No further examination of these claims is required unless and until such rejection has been overcome. However, if the search of the single elected invention develops prior art which would render both the elected invention and the improper Markush claim(s) unpatentable, such prior art may be applied in rejections of both without a complete search of the subject matter of the improper Markush claim(s). Otherwise, only true generic claims and those restricted to the elected invention will be examined in the usual manner.

[Paragraph present in MPEP 803 deleted.]

Review of the rejection will be by appeal to the Board of Appeals under 35 U.S.C. 134.

<sup>4</sup> MPEP 706.03(y) provides, in pertinent part:

Ex parte Markush, 1925 C.D. 126; 340 O.G. 839, sanctions, in chemical cases, claiming a genus expressed as a group consisting of certain specified materials. This type of claim is employed when there is no commonly accepted generic expression which is commensurate in scope with the field which the applicant desires to cover. \* \* \*

Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation then "wherein R is A, B, C or D" shall also be considered proper.

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At the outset, the board decided that §121 was an adequate legal basis for the examiner to reject a single claim "em-  
bracing" more than one independent and distinct invention. In support thereof, the board incorporated two board decisions<sup>5</sup> which discussed the interrelated rejections of "misjoinder under 35 U.S.C. 121" and "as being improper Markush claims" as applied here. The board analyzed the claims in light of those decisions and found them to contain multiple independent and distinct inventions.

Appellants argue before this Court that each of the claims is directed to but a single invention and §121 is not a proper ground for rejection in any event.

### Opinion

[1] The board affirmed the examiner's rejection of claims 1-6 "as being improper Markush claims and misjoinder under 35 U.S.C. 121." However, the reasoning of the board shows that the analysis of the "improper Markush claims" rejection was to be supportive of the rejection under §121 rather than alternative to it. We have jurisdiction over both rejections,<sup>6</sup> but

<sup>5</sup> The board incorporated both *Ex parte Dorlars*, Appeal No. 148-56, decided May 2, 1975, reproduced in the record, and *Ex parte Haas*, 188 USPQ 374 (Bd. App. 1975). The board stated in *Dorlars* that:

What we do find relevant is the single question: does the Examiner have legal authority to attack the propriety of an individual claim, whether of the Markush-type or otherwise, which includes a plurality of independent and distinct inventions? We think clearly the answer is "yes."

The board based its conclusion in *Dorlars* on §121 and further stated:

Clearly the mere fact that review of decisions requiring restriction within a single claim is available under 35 USC 134, whereas decisions requiring restriction between claims are not, cannot serve to limit application of the statute. That relates only to the issue of jurisdiction to review; it has no bearing on the scope of the statute itself — on the scope of authority conferred. In *Ex parte Haas*, the board decided that Rule 141, 37 CFR 1.141 regards an allowable generic claim as one that does not include more than one independent and distinct invention. The board decided that §121 is a legal basis for rejecting a single claim as an improper Markush claim.

<sup>6</sup> 37 CFR 1.196(a) provides that in decisions of the board:

The affirmation of the rejection of a claim on any of the grounds specified constitutes a general affirmation of the decision of the pri-

mary examiner on that claim, except as to any ground specifically reversed.

[2] An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of §112. We have decided in the past that §112, second paragraph, which says in part "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," allows the inventor to claim the invention as he contemplates it. In *re Wolfrum*, 486 F.2d 588, 179 USPQ 620 (CCPA 1973).

[3] As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.<sup>7</sup>

[4] It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to restrict an application to one of several claimed inven-

See also *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

<sup>7</sup> See *Fields v. Conover*, 58 CCPA 1366, 443 F.2d 1386, 170 USPQ 276 (1971), wherein a subgenus was not described and *In re Ruschig*, 54 CCPA 1551, 379 F.2d 990, 154 USPQ 118 (1967), wherein a species of a properly described genus was found not to be described.

tions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to reject a particular claim on that same basis.

[5] Even though the statute allows the applicant to claim his invention as he sees fit, it is recognized that the PTO must have some means for controlling such administrative matters as examiner caseloads and the amount of searching done per filing fee.<sup>8</sup> But, in drawing priorities between the Commissioner as administrator and the applicant as beneficiary of his statutory rights, we conclude that the statutory rights are paramount. We hold that a rejection under §121 violates the basic right of the applicant to claim his invention as he chooses.

[6] Appellants contend that the examiner's action in withdrawing claims 8-13, 16, 17, 20, 22 and 23 from consideration as drawn to nonelected inventions constitutes a rejection under the holding of *In re Haas*, 486 F.2d 1053, 179 USPQ 623 (CCPA 1973), and, therefore, the board improperly found a lack of jurisdiction. We do not agree. Clearly our decision in *In re Hengehold*, 58 CCPA 1099, 440 F.2d 1395, 169 USPQ 473 (1971), disposed of the theory that a restriction requirement and the subsequent action of the examiner in withdrawing nonelected claims from consideration,<sup>9</sup> per se, constitutes a rejection.

<sup>8</sup> We take notice of a practice formerly utilized by the PTO and found in the MPEP: 705 Patentability Reports

Where an application, properly assigned to one examining group, is found to contain one or more claims per se classifiable in one or more other groups, which claims are not divisible inter se or from the claims which govern classification of the application in the first group, the application may be referred to the other group or groups concerned for a report as to the patentability of certain designated claims. This report will be known as a Patentability Report (P.R.) and will be signed by the primary examiner in the reporting group.

The report, if legibly written, need not be typed.

Note that the Patentability Report practice is suspended, except in extraordinary circumstances. See §705.01(e).

We further note the authority of the Commissioner under 35 USC 41(b) to "establish charges for \* \* \* services furnished by the Patent and Trademark Office."

<sup>9</sup> 37 CFR 1.142(b) provides:

(b) Claims to the invention or inventions

tion. An exception is found in *In re Haas*, supra, wherein we determined that the examiner's action in withdrawing claims was a rejection because the "claims were withdrawn from consideration not only in this application but prospectively in any subsequent application because of their content." 486 F.2d at 1056, 179 USPQ at 625. (Emphasis ours.) We do not understand the PTO to make such a holding with respect to claims 8-13, 16, 17, 20, 22 and 23, nor that appellants argue that the PTO does so. Indeed, we note that appellants admitted in their brief before the board that claims 8-13 and 23 were "properly withdrawable." Consequently, the board's dismissal of the appeal to claims 8-13 and 23 was correct. The Commissioner's brief admits that claims 16, 17, 20 and 22 contain species of the invention of generic claim 1 and would be provided an examination on the merits should the §121 rejection be reversed. We remand for appropriate action on claims 16, 17, 20 and 22, and dismiss the appeal of claims 8-13 and 23 for lack of jurisdiction.

The decision of the board affirming the rejection under §121 is reversed, and the case is remanded for consideration of the "improper Markush" rejection of claims 1-6 and appropriate action on claims 16, 17, 20 and 22. The appeal of claims 8-13 and 23 is dismissed for lack of jurisdiction.

#### Reversed and Remanded

Rich, Judge, concurring.

I concur in the result reached in the main opinion, but there are a few points I wish to make clear.

35 USC 121 deals with a matter of PTO practice known as "requirements for division" prior to the 1952 Patent Act which, for the first time, provided a statutory provision on this subject. It did so, under the heading "Divisional Applications," by giving the Commissioner a discretionary, unappealable power to restrict an application to one of several claimed inventions when those inventions were found to be "independent and distinct." 35 USC 121, first sentence; see also P. J. Federico, "Commentary on the New Patent Act" 35 USCA p. 1, at p. 34 (1954).

not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

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d, are nevertheless nsideration by the subject however to t the requirement n or overruled.

Ever since *Ex parte Eagle*, 1870 C.D. 137 (Com'r. Pats. 1870), at least, the expression used in §121, "two or more \* \* \* inventions are claimed," has connoted separate claims to separate inventions. It has no reference to generic or broad claims which "embrace" (the term used by the examiner and the board herein) or "cover" (the term used in the solicitor's brief in support of the board) two or more inventions. Section 121 nowhere uses the words "embraced" or "covered." It says "claimed," and that I take to mean what it has always referred to in the terminology of the patent law, a "claim" or definitional paragraph which, in the words of §112, second paragraph, is "particularly pointing out and distinctly claiming the subject matter the applicant regards as his invention."

Dealing, as it does, with requirements for restriction, §121 says nothing whatever about the rejection of claims, a matter entirely separate from restriction. For one thing, rejections are appealable to the board and restriction requirements are not. *Federico*, op. cit. p. 34; 37CFR§1.144.

On this appeal from the rejection of claims 1-6 we do not have before us a restriction requirement under §121. Such a requirement would not have been appealable to the board. We have before us an appeal from affirmance of a rejection. The examiner purported to base it on §121 and the board accepted that theory, citing in support its own prior decision in *Ex parte Haas*, 188 USPQ 374, wherein it had said, "We believe the referred to section of the patent statute [§121] does provide a basis for such a rejection," namely, a rejection of a single claim "drawn to a multiplicity of independent and distinct inventions."<sup>1</sup>

In dealing with claims 1-6, in spite of the fact there are multiple claims, we are not dealing with separate claims to separate inventions. Claim 1 is a generic claim and claims 2-6 are dependent thereon. They are all generic claims but of varying scope. They are treated together and each claim is rejected on the same ground, as being drawn to multiple allegedly independent and distinct inventions. Careful review of all statements by the examiner and the board makes it clear beyond question that

the only basis asserted for rejecting claims 1-6 is that they cover or embrace or are directed to a plurality of independent and distinct inventions, and this is the sole reason given for saying they are "improper Markush claims" or for saying there is "misjoinder [of inventions] under 35 USC 121." Section 121 is asserted as the only legal basis for this rejection.<sup>2</sup>

The practice here challenged is tantamount to a refusal by the PTO to examine a single Markush claim in a single application because, in its opinion, it is broad enough to "embrace" or "cover" a plurality of inventions which, if presented separately, would be separately patentable, assuming any one of them to be prior art.<sup>3</sup> The label it attaches to such a broad claim is "improper Markush" and the situation is described as "misjoinder."

The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim "embraces" or "covers" a multiplicity of inventions, in the sense of "dominating" them, which inventions might be separately patentable if and when presented in separate applications. Logically, this is not a sufficient excuse for refusing to examine a claim on its merits for compliance with 35 USC 101, 102, 103, and 112. None of those statutory sections, of course, justifies a refusal to examine.

The only justification or statutory authority put forward for refusing to examine is 35 USC 121. There is nothing therein, however, to excuse a refusal to examine an elected invention or an applicant's generic (broad) claim reading thereon, notwithstanding the generic claim reads on nonelected inventions and possibly many others, all potentially separately patentable. The PTO's own rules recognize the distinction between generic claims and separately patentable inventions encompassed or covered thereby. 37

<sup>2</sup> In addition to §121, the examiner relied on the Commissioner's notice published May 1, 1974, in 922 O.G. 1016, now MPEP 803, as authorizing the rejection. That notice also, and solely, relies on §121 for authority. In view of our decision here, it is obvious that the substance of the notice and the MPEP provision corresponding to it are as lacking in foundation as the rejection we are reversing.

<sup>3</sup> This is the essence of the test for independence and distinctness set forth in the third paragraph of the Commissioner's notice of May 1, 1974, in determining whether the examiner has authority to reject a claim, under the fourth paragraph of the notice.

<sup>1</sup> Even the dissenting member of the board, who felt the "Markush" claims there involved were not to "independent and distinct" inventions, agreed that §121 was a proper "legal basis" for a rejection.



CFR §1.141 deals *explicitly* with "independent and distinct inventions"<sup>4</sup> even permitting five of them to be patented on one application along with a generic claim. As to species in excess of five specifically claimed, it is implicit that they may still fall within the "coverage" of the generic claim even if separately patented. It is elementary patent law that the number of "species" "covered" by a patent having a generic claim is virtually without limit notwithstanding the limitation of Rule 141 to five species "specifically claimed." So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim — no matter how broad, which means no matter how many independently patentable inventions may fall within it.

Of course a broad claim may be unpatentable for any number of reasons, but we are not here dealing with a question of patentability under the statute but with a refusal to examine.

The only basis here claimed in support of the labels "improper" and "misjoinder" is the scope of the claim. That is not sufficient excuse.

As for the true meaning of the words "two or more independent and distinct inventions are claimed" in §121, being based — as they were — on the "division" practice existing in the then Patent Office in 1952, there can be no doubt they refer to separate inventions separately claimed and to a requirement to put separate claims in separate applications or at least to restrict one application to one claimed invention. There is no indication that enactment of §121 contemplated refusing examination to generic claims because of their scope or that applicants were to be denied the right to present single claims of any breadth they chose and have them examined.

The PTO effort of the past few years to justify its refusal to examine by issuing a "rejection" pursuant to the May 1, 1974, notice (MPEP 803) on the basis of §121 is mere semantic gamesmanship.

With respect to the remand to consider the "improper Markush" rejection of claims 1-6, it is my view, based on careful analysis of the rejections actually made,

that the PTO, following the May 1, 1974, notice (922 OG 1016), created a new kind of "improper Markush" rejection based on 35 USC 121 which we are reversing. There remains, however, a vast body of precedent antedating the 1974 notice on what proper "Markush" claims are. As I understand the majority's remand, it is for the purpose of examining claims 1-6 under the pre-notice law relating to Markush practice in the process of examining these claims on their merits. Until now, such examination has been refused because they "cover" or "embrace" too much, a basis of rejection we find impermissible.

### Court of Customs and Patent Appeals

In re Haas

No. 78-536

Decided June 30, 1978

#### PATENTS

##### 1. Court of Customs and Patent Appeals — Issues determined — Ex parte patent cases (§28.203)

There is no issue before Court of Customs and Patent Appeals that claims are drawn to improper Markush groups where there is no rejection on that ground.

##### 2. Applications for patent — Divisional (§15.5)

##### Claims — Miscellaneous objections (§20.70)

##### Joinder of invention — In general (§42.01)

##### Pleading and practice in Patent Office — Rejections (§54.7)

Section 121 does not provide basis for rejection of claim.

##### Particular patents — Polymerization

Haas, Novel Polymerization Initiators, rejection of claim 7 and 8, reversed and remanded.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Howard C. Haas, Serial No. 821,511, filed May 2, 1969 continuation-in-part of application, Serial No. 630,222 filed Apr. 12, 1967. From decision rejecting claims 7 and 8, applicant appeals. Reversed and remanded.

<sup>4</sup> Note Rule 141's wording: "Two or more independent and distinct inventions may not be claimed in one application, *except* \* \* \*." (My emphasis.) Compare the wording of 35 USC 121.

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**Court of Customs and Patent Appeals**

In re Harnisch

No. 79-614

Decided June 12, 1980

**PATENTS****1. Claims — Broad or narrow — Markush type — In general (§20.2051)****Pleading and practice in Patent Office — In general (§54.1)**

Patent and Trademark Office has one practice with respect to claims directed to compounds per se, and different one when they are directed to process or composition involving combination of ingredients wherein Markush-type definition-by-enumeration is used in defining process, step or composition element.

**2. Board of Appeals — Procedure and practice (§19.45)****Claims — Broad or narrow — Markush type — In general (§20.2051)**

Patent and Trademark Office Board of Appeals has perfect right to rely on rules, principles, or tenets derivable from cited cases that would enable it to determine whether claims before it were, or were not, in proper form to be examined for patentability, but there is no "doctrine" with respect to Markush practice.

**3. Pleading and practice in Patent Office — In general (§54.1)**

Patent applications are examined in Patent and Trademark Office for compliance with statutory provisions of 35 U.S.C. 100, 101, 102, 103, and 112; these are considered to be examinations "on the merits."

**4. Applications for patent — Divisional (§15.5)****Claims — Broad or narrow — Markush type — In general (§20.2051)****Joinder of invention — In general (§42.1)****Pleading and practice in Patent Office — Rejections (§54.7)**

Applicant has right to define what he regards as his invention as he chooses, so long as his definition is distinct and supported by enabling disclosure, but there is possibility of such thing as "improper Markush grouping," although it does not have specific statutory basis.

**5. Claims — Broad or narrow — Markush type — Chemical (§20.2053)****Joinder of inventions — Tests of (§42.9)**

Claimed compounds that all belong to subgenus that is not repugnant to scientific classification are part of single invention so that there is unity of invention and Markush grouping was proper.

**6. Applications for patent — In general (§15.1)****Claims — Broad or narrow — Markush type — In general (§20.2051)****Joinder of invention — In general (§42.1)**

Each case involving propriety of Markush groupings must be decided on its facts on case by case basis; Court of Customs and Patent Appeals adheres to holding in *In re Weber*, 198 USPQ 328, and *In re Haas*, 198 USPQ 334; unity of invention concept is not to be confused with "misjoinder" under 35 U.S.C. 121 rejection; "unity of invention" is appropriate term to apply where unrelated inventions are involved, that is, inventions that are truly independent and distinct.

**7. Court of Customs and Patent Appeals — Issues determined — In general (§28.201)**

Alleged error that is not argued is deemed abandoned.

**Particular patents — Dyestuffs**

Harnisch, Coumarin Compounds, rejection of claims 1 and 3 through 8, reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Horst Harnisch, Serial No. 559,978, filed Mar. 19, 1975. From decision rejecting claims 1 and 3 through 8, applicant appeals. Reversed.

Leonard Horn, New York, N.Y., for appellant.

Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, Richard Baldwin, and Miller, Associate Judges, and Ford, Judge.\*

\* The Honorable Morgan Ford, Judge, United States Customs Court, sitting by designation.

This is a United States Patent Office (PTO) decision under 37 U.S.C. 1321, appeal from a decision of the Patent and Trademark Office (PTO) in a Markush-type claim, and is not a claim group.

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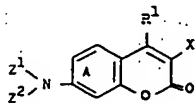


This appeal is from the decision of the United States Patent and Trademark Office (PTO) Board of Appeals (board) rejecting, under 37 CFR 1.196(b), claims 1 and 3-8<sup>1</sup> of appellant's application, serial No. 559,978, filed March 19, 1975, for "Coumarin Compounds," on the sole ground that these claims are "drawn to improper Markush groups." We reverse.

#### The Invention

The claimed compounds encompass coumarin compounds useful as dyestuffs. Some of them may be used as intermediates to make other dyestuffs. Claim 1 is representative and reads as follows:

1. Coumarin compounds which in one of their mesometric limiting structures correspond to the general formula



wherein

X represents aldehyde, azomethine, or hydrazone,

R<sup>1</sup> represents aryl or alkyl,

Z<sup>1</sup> represents hydrogen, alkyl, cycloalkyl, aralkyl, aryl or a 2- or 3-membered alkylene radical connected to the 6-position of the coumarin ring and

Z<sup>2</sup> represents hydrogen, alkyl, cycloalkyl, or a 2- or 3-membered alkylene radical connected to the 8-position of the coumarin ring

and wherein

Z<sup>1</sup> and Z<sup>2</sup> conjointly with the N atom by which they are bonded can represent the remaining members of an optionally benz-fused heterocyclic ring which, like the ring A and the alkyl, aralkyl, cycloalkyl and aryl radicals mentioned, can carry further radicals customary in dye-stuff chemistry.

Claims 3-6 depend from claim 1, adding further limitations with respect to the substituents; claim 7 is an independent claim of the same type as claim 1 but of much greater length in naming substituents, and claim 8 depends therefrom as well as from claim 4.

<sup>1</sup> The board also newly rejected claim 6 as indefinite under 35 USC 112 due to an improper dependence and claim 8 as improperly dependent from two claims, 7 and 4. Appellant acknowledges in his brief that no appeal is taken from either of these rejections, wherefore we need not consider them.

The instant coumarins are said to be useful for dyeing synthetic or natural fibers, plastics, and liquids such as oils and lacquers. Of apparently significant commercial value is the dyeing of either the aqueous or organic based inks preferred in rotary gravure printers for non-textile articles.

Clear shades of yellows to oranges are purportedly achieved with good fastness properties. In addition, a strong chartreuse to yellow fluorescence supposedly occurs upon exposure to either natural or ultraviolet light. The fluorescence is said to be especially suitable for tunable dye lasers.

#### The Rejection

The examiner, relying on no prior art, rejected claims 1 and 3-8 under 35 USC 121 "as containing an improper Markush group and misjoinder." More explicit reasons were said to be set forth in the earlier Office Action of May 12, 1976. In that action the examiner enumerated ten species of compounds encompassed by the claims. Beside each group he listed the various PTO class 260 subclasses into which the species fall.

The significance of this segmentation was declared to be twofold. In the examiner's words,

A reference anticipating one member [of the listed groups] would not render any other member obvious under 35 USC 103. The members are not so few in number or so closely related that a search and examination of the entire claim cannot be made with [sic, without?] serious burden.

#### The Board

The board summarily reversed the rejection of the appealed claims under 35 USC 121. Citing our decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978), and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), decided subsequent to the examiner's rejection, the board stated that "35 USC 121 does not form the basis for rejection of a claim \* \* \*."

A new rejection was then made by the board under 37 CFR 1.196(b),<sup>2</sup> rejecting the claims as "drawn to improper Markush groups." After a lengthy listing of decisions from 1925 to 1953 reviewing "Markush practice," by the Commissioner, the board,

<sup>2</sup> 37 CFR 1.196(b), in relevant part, reads:

(b) Should the Board of Appeals have knowledge of any grounds not involved in the appeal for rejecting any appealed claim, it may include in its decision a statement to that effect with its reasons for so holding, which statement shall constitute a rejection of the claims. \* \* \*

and this court,<sup>4</sup> the board expounded its theory of the propriety of its new "improper Markush group" rejection solely on the basis of "judicially created doctrine," as follows (our emphasis):

Applying the facts of this case to the principles enunciated, we find that the members of the Markush groups of the claims do not belong to a known or recognized genus and possess widely different physical or chemical properties. Aside from the obvious fact that the compounds encompassed by the claims are not functionally equivalent, said compounds, considered as a whole, are so dissimilar and unrelated chemically or physically that it would be repugnant to accepted principles of scientific classification to associate them together as a generic group. For example, the types of derivatives encompassed by the Markush claim may include polyfused N-heterocyclics, cyclic, acyclic and aromatic amines, aryloxyalkylamines, amides, sulfonamides, phthalimides, quaternary ammonium salts, phosphorous

<sup>4</sup> As detailed by the board:

Markush practice has a long history in the Office dating back to at least *Ex parte Markush*, 1925 CD 126, 340 OG 839. Since that time, the Office and the Court of Customs and Patent Appeals had considered rejections based on the propriety and/or limitations of Markush-type claims. See, for example, *Ex parte Palmer et al*, 1930 CD 3, 398 OG 707; *Ex parte Burke*, 1934 CD 5, 441 OG 509; *Ex parte Dahlen*, 1934 CD 9, 441 OG 510; *In re Swenson et al*, 30 CCPA 764, 132 F.2d 336, 1943 CD 175, 56 USPQ 180 (1942); *In re Haas et al*, 31 CCPA 895, 141 F.2d 122, 1944 CD 234, 60 USPQ 544 (1944); *In re Kingston*, 32 CCPA 1013, 149 F.2d 181, 1945 CD 297, 65 USPQ 371 (1945); *In re Ruzicka et al*, 32 CCPA 1165, 150 F.2d 550, 1945 CD 449, 66 USPQ 226 (1945); *In re Archbold*, 33 CCPA 725, 151 F.2d 350, 1946 CD 63, 67 USPQ 102 (1945); *In re Thompson et al*, 33 CCPA 942, 154 F.2d 189, 1946 CD 280, 69 USPQ 148 (1946); *In re Winnek*, 34 CCPA 946, 160 F.2d 572, 1947 CD 280, 73 USPQ 225 (1947); *In re Jones*, 34 CCPA 1150, 162 F.2d 479, 1947 CD 484, 74 USPQ 149 (1947); *In re May et al*, 36 CCPA 833, 172 F.2d 593, 1949 CD 119, 80 USPQ 515 (1949); *In re Schechter et al*, 40 CCPA 1009, 205 F.2d 185, 1953 CD 323, 98 USPQ 144 (1953).

Additional analysis of Markush practice appears particularly in the following articles:

Kelly et al., *Markush Claims*, 37 JPOS 164 (1955), (a 75-page exhaustive review of the practice by a committee of the Michigan Patent Law Association).

Walterscheid, *Markush Practice* Revised, 61 JPOS 270 (1979).

heterocyclics, phosphates, aldehydes, azomethines, hydrazones, ethers, esters, halogens, alcohols, nitriles, piperidines, furanes, pyrroles, indoles, amongst others. It is clear that on this record the involved compounds cannot be considered functionally equivalent, in fact, some being no more than intermediates for the others. The foregoing is borne out by the record wherein appellant discloses that the various groups or compounds possess different physical or chemical properties. Nowhere in the record has it been established or even alleged that the variety of compounds included within the explicit scope of the claims are recognized by the art as being functionally equivalent. The functional groups involved herein, as amplified above, are so structurally diverse they would be expected to possess dissimilar and unrelated chemical and physical properties. The mere fact that there is a single structural similarity (i.e., the coumarin group) is not in itself sufficient reason to render all the embodiments functionally equivalent, particularly when the ultimate properties of the final products would not be expected to possess any recognized functional relationship. Thus, the fact that the coumarins are in most part indicated as being dyestuffs (others being intermediates for dyes) is not sufficient, since, depending upon their structure, they may be subject to different modes of application and use.

#### Appellant's Position

Appellant, picking up the board's statement that its rejection "has basis in judicially created doctrine," as shown by the cases it cited, rather than in the patent statutes, asks this court, first, whether claims can be rejected on a judicially-created doctrine rather than on some statutory basis, such as 35 USC 121 on which the examiner relied. If they can, then appellant asks, second, whether the compounds claimed are sufficiently closely related to be joined in the same claim.

On the first point, appellant seems to assume some unstated specific "doctrine" on which the board acted, against which he inveighs, and which he says cannot stand, urging us not to create a "doctrine."

On the second point, appellant discusses the fact situation underlying the appealed claims, showing that the compounds are all dyestuffs, that the members of group X, claim 1, are closely related, that the compounds are all coumarins, and cites two board opinions reversing rejections by the examiner of claims structured similarly to

appellant Brouard, and *Ex parte* App. 1965 involved a structure constituent "ed a list column in reversed v Markush dent and

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appellant's claims, namely, *Ex parte Brouard*, 201 USPQ 538 (Bd. App. 1976), and *Ex parte Taylor*, 167 USPQ 637 (Bd. App. 1969). The former case, like this one, involved a claim 24 to a dyestuff defined by structure containing, *inter alia*, a substituent "B" the definition of which included a list of alternatives occupying about a column in the USPQ report. The rejection reversed was on the ground of "improper Markush group" and misjoinder of independent and distinct inventions.

#### The PTO Position

The solicitor's brief contains helpful digests of certain key cases selected from the many which discuss "Markush practice" from its inception in 1924 through 1979. It supports the board's new rejection on the ground the claims are drawn to "improper Markush groups." After stating that "Markush practice" is one of long standing and involves a vast body of precedent, the brief relies primarily on the following contentions: (1) there need not be a specific statutory basis for the rejection, citing by analogy obviousness-type double patenting rejections which are case-law based; (2) the materials set forth in the "Markush group" ordinarily must belong to a recognized physical or chemical class or to an art-recognized class; and (3) the claimed group must not be "repugnant to accepted principles of scientific classification."

A principal factual contention in the solicitor's brief is that appellant's claimed compounds include (1) dyestuffs, (2) intermediates for making dyestuffs, or (3) both, and fails to reveal the utility *per se* of each compound. However, at oral argument the solicitor announced with admirable candor that, having considered appellant's reply brief, he had concluded that there is in fact no class "(2)" because all of the claimed compounds are dyestuffs though some of them could also be used as intermediates to make still other dyestuffs.

The solicitor also cited authority to the effect that each "improper Markush" case must be decided on the basis of its own facts. He also stated that current PTO "Markush practice" is as set forth in section 706.03(y) of the Manual of Patent Examining Procedure (MPEP), 3d ed., Rev. 46, July 1976, reproduced in full as an appendix hereto.

#### Opinion

We will first express our views concerning the PTO's reliance on "judicially created doctrine" in its rejection of claims for "improper Markush grouping." Appellant in-

jected this point into the case by contending that the PTO had no right to rely on doctrine because a statutory basis for rejection must be stated. He also seems to contend that there is no "doctrine" and that while this court could create one it should not do so. In consequence, much of the oral argument was involved with the court trying to find out from the solicitor what, if any, "doctrine" was being relied on by the PTO, no clear answer being forthcoming — with good reason.

Upon reflection and consideration of the cases cited by the board, the discussion of those and others by the solicitor, and the recorded history of Markush practice, it appears to us that all of the discussion of "doctrine" is beside the point because there is no "Markush doctrine." Appellant never made clear or specific what "doctrine" he was referring to and the solicitor, justifiably, was unable to point one out to us.

"Markush" was the name of an applicant for patent (Eugene A. Markush) who happened to use in a claim a type of definition of a genus or subgenus by enumeration of species, which he did not devise and which had been used before in patent claims.<sup>4</sup> The examiner considered the claim to be "alternative" in form, objected to it, and Markush petitioned the Commissioner. Assistant Commissioner Kinnan, in *Ex parte Markush*, 1925 CD 126 (Com. Pat. 1924), approved the form of claim and granted the petition, thus requiring the examiner to examine it for patentability. Thus the name "Markush" became attached to a type of claim expression, and that is all it connotes. As others rang changes on the type of expression used by Markush and approved by Assistant Commissioner Kinnan, further decisions and opinions on petitions and in appeals ensued and a considerable body of case law evolved, approving and disapproving various forms of Markush-type expression, from which cases a number of rules can be deduced. Like other bodies of case law, however, the body pertaining to what may properly be called Markush practice has not been altogether consistent and has evolved through the years. Among the

<sup>4</sup> The Markush opinion points out that in another division of the Patent Office claims "of this character" have been allowed, citing Patents Nos. 1,472,048 and 1,486,635, and that, long before that, Patent No. 901,675 contained claims in which "the letter R is used in a chemical formula as standing for CH<sub>3</sub> or COOH" and that such claims had frequently been allowed. Markush ultimately obtained Patent No. 1,506,316, Aug. 26, 1924.

inconsistent decisions, some of them were by this court. In the PTO, one of the changes that took place was the abandonment of the rule against the use of "or" in an enumeration of alternative materials that might be used in a claimed invention, which rule was the basis of the objection giving rise to the Markush decision. A specific example will be found in MPEP 706.03(y). Not long ago, by a Notice under date of May 1, 1974, the PTO set up a "Practice Re Markush-Type Claims" and later incorporated the Notice in MPEP section 803. Since the MPEP revision of July 1978, that practice has not been followed because of two decisions of this court and MPEP 803 now contains this statement:

#### Practice Re Markush-Type Claims

The subject matter formerly under this subtitle has been cancelled in view of the decisions *In re Weber et al.*, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 198 USPQ 334 (CCPA 1978).

Thus have decisions changed the Markush practice.

[1] It is also clear that Markush practice does not refer to a *single* rule. As may be seen from MPEP 706.03(y) set forth in the appendix, the PTO has one practice with respect to claims directed to compounds *per se* and a different one when they are directed to a process or composition involving a combination of steps or ingredients wherein the Markush-type definition-by-enumeration is used in defining a process step or composition element.

In summary, there is no "doctrine" to be considered but only a body of case law, emanating from both "higher" and "lower" authority, not altogether consistent, the latest decisions tending to carry the most weight as precedent.

[2] Coming now to appellant's first contention that the board had no right to rely on "judicially created doctrine," we note that a doctrine, by definition, is, according to Black's Law Dictionary, revised 4th ed., "A rule, principle, theory, or tenet of the law." As is clear from the entire board opinion, what it meant was that it intended to rely on rules, principles, or tenets derivable from the cases it cited which would enable it to determine whether the claims before it were or were not in proper form to be examined for patentability. Our ruling on this point is that it had a perfect right to do so. But there is not one "doctrine" or rule; there are many.

The next questions are whether the board correctly interpreted the facts and whether

it correctly applied the rules of law derivable from the cases to the facts. Before considering these questions, we take note of some recent history respecting Markush practice.

[3] In the PTO, patent applications are examined for compliance with the statutory provisions of Title 35, United States Code, as set forth in sections 100, 101, 102, 103, and 112. These are considered to be examinations "on the merits." There are also procedural questions arising under section 121 and related PTO rules concerned with "restriction practice." See MPEP, Chapter 800. As shown by the *In re Haas* cases,<sup>6</sup> issues arose from PTO refusal to consider on the merits single claims to groups of chemical compounds of broad scope unless each claim was first broken up into a plurality of claims of lesser scope. The first PTO position was that it would neither consider *nor reject* the claims, thus foreclosing appeal to the board or to this court. After this position was held to be a rejection, the PTO promulgated its May 1, 1974 Notice, which authorized rejection on the basis of §121, relating to restriction, thus combining the two matters of Markush practice and restriction practice. In *Haas II* (see note 6, *supra*), this court held that §121 could not be used as the basis for rejecting a *single* claim or compelling its replacement by a plurality of narrower claims before examination on the merits would be made. *Haas II* was decided at the same time as *In re Weber*, *supra*, involving similar issues, and *Haas II* was decided on the basis of the opinion in *Weber*. We note that in *Weber* the majority opinion regarded the "improper Markush grouping" reasoning of the board as having been merely "supportive of the rejection under §121 rather than alternative to it" and dealt only with the §121 rejection, reversing it and remanding the case to the PTO for consideration, separately, of the "improper Markush" rejection. The concurring opinion, by the present writer, pointed out with respect to that remand, that there existed a vast body of case law relating to Markush practice. We have not yet heard again from *Weber*, but the present case comes to us in similar posture. Note that this case involves an improper Markush rejection by the examiner based on §121 which the board reversed in view of

<sup>6</sup> Ex parte Haas, 175 USPQ 217 (Bd. App. 1972), reversed, *In re Haas*, 486 F.2d 1053, 179 USPQ 623 (CCPA 1973) ("Haas I"); Ex parte Haas, 188 USPQ 374 (Bd. App. 1975), reversed, *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978) ("Haas II").

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), patent applications are in compliance with the statutory provisions 35, United States Code, sections 100, 101, 102, 103, are considered to be of extreme merits." There are also reasons arising under section 101 TO rules concerned with the same. See MPEP, Chapter 1, the *In re Haas* cases,<sup>6</sup> TO refusal to consider on the merits claims to groups of compounds of broad scope unless first broken up into a group of lesser scope. The first that it would neither conclude claims, thus foreclosing the door to this court. After held to be a rejection, the Board's May 1, 1974 Notice, rejection on the basis of restriction, thus combining of Markush practice and . In *Haas II* (see note 6, held that §121 could not be a basis for rejecting a single claim by its replacement by a number of claims before examination merits would be made. It was at the same time as in *In re Jones* involving similar issues, decided on the basis of the Board. We note that in *Weber* the Board regarded the "improper grouping" reasoning of the Board as merely "supportive of §121 rather than alternative to it with the §121 claim and remanding the consideration, separate rejection of Markush" rejection. In *Haas II*, by the present Board with respect to that rejected a vast body of case, Markush practice. We have, in *Haas II*, from *Weber*, but the Board to us in similar posture. It involves an improper grouping by the examiner based on the Board reversed in view of

<sup>6</sup> 75 USPQ 217 (Bd. App. 1973) ("Haas I"); *Ex parte* (Bd. App. 1975), reversed, 51, 198 USPQ 334 (CCPA 1977).

*Weber*, substituting its own improper Markush rejection based only on judicial precedent and divorced from §121.

[4] Anent appellant's argument that the board should not be allowed to rely solely on judicial precedent, we think it should be clear from our actions in *Weber* and *Haas II* that we there recognized the possibility of such a thing as an "improper Markush grouping." We were and are aware that it does not have a specific statutory basis, as we are aware of an applicant's right to define what he regards as his invention as he chooses; so long as his definition is distinct, as required by the second paragraph of §112, and supported by enabling disclosure, as required by the first paragraph of §112. *In re Wakefield*, 57 CCPA 959, 422 F.2d 897, 164 USPQ 636 (1970); *In re Borkowski*, 57 CCPA 946, 422 F.2d 904, 164 USPQ 642 (1970).

In the early years of the development of Markush practice, many of the cases involved the problem of clarity — avoiding the uncertainties of alternatives and the like. More recently, the cases have centered on problems of scope, which are related to enablement. Assuming enablement, however, there remains a body of Markush-practice law regarding Markush-type claims, particularly in the chemical field, concerned more with the concept of what might be better described as the concept of unity of invention. At least the term would be more descriptive and more intelligible internationally than is the more esoteric and provincial expression "Markush practice." It is with this unity of invention concept in mind that we approach the propriety of the appealed claims.

Over thirty years ago this court decided *In re Jones*, 34 CCPA 1150, 162 F.2d 479, 74 USPQ 149 (1947), reversing an "improper Markush group" rejection of claims to chemical compounds which were growth-regulating compositions for plants, fungicides, and insecticides. Notwithstanding their various properties, the court found all of the compounds included in the claims were plant growth stimulants, thus having a common function. The court noted that in any Markush group the compounds "will differ from each other in certain respects." It laid down the proposition, with which the PTO agrees in its MPEP, that in determining the propriety of a Markush grouping the compounds must be considered as wholes and not broken down into elements or other components. It also held, in agreement with the board, that each case of this type must be considered on its own facts. Citing *Ex parte Clark*, 11 USPQ 52

(Com. Pat. 1931), a case decided by the author of the original Markush opinion, it noted that "the inclusion in Markush groups of compounds which differed widely in some respects," namely, aliphatic, aromatic, and aralkyl compounds, had been permitted. It cited *Ex parte Dahlen*, 42 USPQ 208 (Bd. App. 1938) as permitting the grouping of compounds having the same nuclei but side chains wherein there was a wide variation. It found the claims before it to cover compounds all belonging to a genus of tetralyl compounds having a substituted methyl group at position 6 and ruled that they had a community of properties justifying their grouping which was not repugnant to principles of scientific classification.

[5] We regard the present case as similar to *In re Jones*, supra, and also the much later decision of the board in *Ex parte Brouard*, supra, in which the board reversed the examiner's "improper Markush" rejection. We conclude that the board here was factually in error in not recognizing that all of appellant's claimed compounds are dyes, as confirmed by the solicitor's admission. The board's reliance on its notion that some of the claimed compounds are "no more than intermediates" overlooked the now admitted fact that they are dyes as well. Clearly, they are all coumarin compounds which the board admitted to be "a single structural similarity." We hold, therefore, that the claimed compounds all belong to a subgenus, as defined by appellant, which is not repugnant to scientific classification. Under these circumstances we consider the claimed compounds to be part of a single invention so that there is unity of invention as was held to be the case in *Ex parte Brouard*, supra, 201 USPQ at 540. The Markush groupings of claims 1 and 3-8 are therefore proper.

[6] As stated above, we decide this and like cases on their facts on a case-by-case basis. It should also be clear from what we have said that we adhere to our holdings in *In re Weber*, supra, and *In re Haas* (Haas II), supra. Nothing we have said herein is intended to change or modify them in any way; nor do we think anything said could be reasonably construed to have such an effect. The "unity of invention" concept is not to be confused with the "misjoinder under 35 USC 121" rejection employed in *In re Weber*. In *Weber* we dealt with the use of 35 USC 121, which deals only with restriction requirements, to support the rejection of a single claim. Here we are concerned only with the rejection of a single claim on the distinct ground that it is directed to an "improper Markush group." Reference to the



widely-recognized concept of "unity of invention" has been made in order to suggest an appropriate term to apply where *unrelated* inventions are involved — inventions which are truly independent and distinct.<sup>7</sup> This case, we find, does not involve such inventions.

[7] Appellant expressly stated in his brief that no appeal was being taken from the rejection of claim 6 under 35 USC 112 or of claim 8 as improperly dependent. In addition, while appellant's reasons of appeal alleged error in the board's supposed dismissal of claims 9-14 and 23-25, this alleged error has not been argued and is therefore deemed abandoned. The appeal with respect to claims 6, 8-14, and 23-25 is therefore dismissed.

The board's rejection of claims 1 and 3-8 as based on "improper Markush groups" is reversed.

Reversed

[Appendix omitted.]

### Court of Customs and Patent Appeals

Southwire Company v. U.S. International Trade Commission et al.

No. 80-21

Decided June 2, 1980

### UNFAIR COMPETITION

#### 1. Court of Customs and Patent Appeals — Jurisdiction (§28.25)

Court of Customs and Patent Appeals, under Section 337(c) of Tariff Act of 1930, has jurisdiction to review International Trade Commission determination in same manner and subject to same limitations and conditions as decision of Customs Court; original appeal from decision of Customs Court must be filed within sixty days after final judgment or order; however, cross-appeal from decision of Customs Court may be filed within fourteen days

<sup>7</sup> Having recognized the possibility of rejecting a Markush group type of claim on the basis of independent and distinct inventions, the PTO may wish to anticipate and forestall procedural problems by exercising its rulemaking powers under 35 USC 6(a), wherein the views of interested parties may be heard.

of date on which first original appeal is filed, even if sixty day appeal period has expired.

#### 2. Court of Customs and Patent Appeals — In general (§28.01)

##### Court of Customs and Patent Appeals — Jurisdiction (§28.25)

Section 337(c) of Tariff Act of 1930 directs Court of Customs and Patent Appeals to treat International Trade Commission like Customs Court in matters of appellate procedure; subsection (c) language was merely shorthand substitute for express procedural provisions parroted those that control procedure in customs appeals; however, effect of section is same, i.e., procedural rules applicable in customs appeals are carried over into ITC practice; thus, Section 337 creates exception to Fed.R.App.P. 20 by making available in ITC practice same fourteen day cross-appeal period available in customs practice.

#### 3. Court of Customs and Patent Appeals — Jurisdiction (§28.25)

Dismissals of first appeals that foreclosed need to file cross-appeals negates any effect of those appeals on cross-appeal period; establishment of separate period for cross-appeals serves salutary purpose of avoiding needless employment of judicial process involved in filing of original appeals in cases in which no such original appeals would be filed in absence of appeal by adversary.

#### 4. Court of Customs and Patent Appeals — Jurisdiction (§28.25)

Rule respecting cross-appeals does not merely enlarge period for original appeal from sixty days to seventy-four days from date of decision being appealed; on contrary, cross-appeal period is fourteen days from first original appeal, without regard to decision date; under Section 337(g) of Tariff Act of 1930, International Trade Commission's positive Nov. 23, 1979 determinations did not become appealable until Jan. 23, 1980; however, Court of Customs and Patent Appeals expresses no view respecting appeal period applicable to original appeals from negative portions of ITC determinations containing both positive and negative findings.

#### 5. Court of Customs and Patent Appeals — Issues determined — In general (§28.201)

### Court of Customs and Patent Appeals — Jurisdiction

#### Parties to

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Appeal from Commission

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ther, potential exhibitors and show visitors may believe that the Defendant's show is somehow related to, or a successor to, the Plaintiff, who has twenty years of experience and good-will in its show.

(15) If the Defendant has to change the literature then the Defendant will incur costs in reprinting the pamphlet and will suffer a brief delay in mailing its pamphlet of a couple of days until the new literature is printed. There is no evidence that the Defendant would lose its customers to the Plaintiff during the reprinting.

#### Conclusions of Law

(1) The Court has jurisdiction of the subject matter pursuant to 28 U.S.C. § 1338.

(2) In deciding whether to issue a preliminary injunction the Court considers the Plaintiff's likelihood of success on the merits, the irreparable harm to the Plaintiff if an injunction is not issued, the harm to the Defendant if an injunction is granted and where the public interest lies. *Blackwelder Furniture Co. v. Seilig Mfg. Co., Inc.*, 550 F.2d 182 (4th Cir. 1977).

(3) The Plaintiff's Complaint alleges a cause of action pursuant to Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). To be successful on the merits the Plaintiff must show that the Defendant distributed advertising materials containing false representations or statements and that a reasonable basis exists for the belief that the Plaintiff is likely to be damaged as a result of the false advertising. *Johnson & Johnson v. Carter-Wallace, Inc.*, 631 F.2d 186, 208 USPQ 169 (2d Cir. 1980).

Further, when a statement is shown to be actually false, consumer reaction to the advertising need not be shown. *American Home Products Corp. v. Johnson & Johnson*, 577 F.2d 160, 165, 198 USPQ 132, 137 (2d Cir. 1978). The court concludes that the Plaintiff's evidence of falsity is sufficient to show a substantial likelihood of success on the merits.

(4) The Plaintiff will be irreparably harmed if an injunction is not issued by the likelihood that many of the Plaintiff's potential exhibitors would decide to do business with the Defendant on the mistaken belief that the two shows are affiliated or on the mistaken belief that the Defendant provides the "only" opportunity in Charlotte to offer exhibits of a home and garden show, whereby the Plaintiff would be deprived of potential and actual exhibitors at its show.

(5) The harm to the Defendant if an injunction is issued is the cost in reprinting and a minor delay in mailing the promotional

literature until the pamphlets are reprinted. This harm can be protected against by requiring the Plaintiff to post an adequate bond.

(6) The Court, therefore, concludes that in balancing the equities between the Plaintiff and the Defendant with respect to the issuance of an injunction, the harm to the Plaintiff, with its twenty years in the business and its established market and customers substantially outweighs the harm to the Defendant.

[1] (7) As the public has an interest in being protected from receiving false advertising the public interest weighs in favor of granting the injunction.

(8) Any finding of fact which is determined to be a conclusion of law is so deemed and any conclusion of law which is determined also to be a finding of fact is so deemed.

Accordingly, pursuant to the findings of fact and the conclusion of law set forth above, IT IS, THEREFORE, ORDERED AND DECREED that:

(1) The Defendant is to delete the word "only" from the phrase in Defendant's literature which states "Charlotte's Only Major Home and Garden Show";

(2) The Defendant is enjoined from distributing during the pendency of this litigation literature containing the representation "Charlotte's Only Major Home and Garden Show"; and

(3) The Plaintiff is to post bond with the Clerk of Court not later than 3:00 p.m. on March 12, 1985 in the amount of \$10,000.00 as required pursuant to Fed.R.Civ.P. 65(c).

#### Commissioner of Patents and Trademarks

In re Application of Hozumi et al.

Opinion dated Feb. 11, 1985

#### PATENTS

##### 1. Specification — In general (§62.1)

Fact that art of cancer chemotherapy is highly unpredictable places burden on drug patent applicants to provide basis for believing speculative statements placed in specification as positive assertion are true, and failing such, ignorance of PTO in not being able to provide scientific reason why assertion is not sound is not justification for permitting assertion to be made, where those of ordinary skill



in art would not accept assertions as believable without some data or other evidence to support it.

Petition under 37 CFR 1.181 requesting that examiner be directed to withdraw requirement to cancel from specification all assertions pertaining to cancer utility. Petition granted in part.

Charles A. Wendel, Harold C. Wegner, Douglas P. Mueller, and Wegner & Bretschneider, all of Washington, D.C., for petitioner.

Van Horn, Director, Group 120.

### On Petition

This is a decision on the petition filed November 19, 1984 under 37 CFR 1.181 requesting that the examiner be directed to withdraw his requirement to cancel from the specification all assertions pertaining to cancer utility.

The file record in this application reveals that the examiner's rejections of the claims in this application as containing an improper Markush group and as being based on a non-enabling disclosure were reversed by the Board of Appeals in a decision dated June 26, 1984. Following the Board decision, the examiner mailed an Office action on September 18, 1984 in which the examiner indicated that all claims in the application were allowable and required applicants to cancel from the specification all assertions pertaining to cancer utility according to the procedures outlined by the CCPA in *In re Gottlieb et al.*, 140 USPQ 665. MPEP 608.01(p). The examiner apparently took the position that the recitation in the specification of a broad genus (e.g. malignant tumors) without specific examples of human and animal in vivo and additional in vitro data does not meet the minimum standard set forth in *In re Jolles*, 206 USPQ 885 (CCPA 1980). Although the utility (35 USC § 101) for the claimed subject matter is supported by other utilities described in the specification disclosure, it is the examiner's position that the reference to utility as an antitumor agent in a warm-blooded animal afflicted by malignant tumors such as leukemia or solid tumor (e.g. digestive organ cancer, lung cancer) is not believable on its face to those of ordinary skill in the art in view of contemporary knowledge in the art.

The examiner did not identify the specific passages in the specification that are required

to be cancelled, but apparently indicated to the attorney of record during a telephone interview (which was not made of record but referred in the petition) that the requirement for cancellation relates only to page 7, lines 2-14 of the instant specification. Petitioners argue that they should be under no obligation to delete any of the disclosure as the statements referenced by the examiner are readily believable and supported by test results, and have been in no way rebutted by the citation of literature.

First, it should be observed that the matter considered in this petition is a side show apart from the main event. The claims in this application have been examined and determined to meet all the statutory criteria for patentability. The application stands in condition for allowance and ready for the issuance of a patent grant except for the presence in the specification disclosure of certain asserted utilities which the examiner believes to be too speculative - i.e. not believable on their face to those of ordinary skill in this art in view of the contemporary knowledge of the art.

Aside from the fact that the examiner's requirement is made pursuant to at least two Office policies (MPEP 608.01(p) and 1302.01), it is appropriate for the Office to require removal of wildly speculative statements if the integrity of a patent as a technical disclosure document is to be maintained and if the Office can avoid misleading the public. It is the policy of the Office (MPEP 608.01(p)-35 USC § 112, last paragraph) to require cancellation of such speculative statements which do not contribute to the technical content of the disclosure. It is also the policy of the Office (MPEP 1302.01) to restrict the descriptive material in the specification disclosure to be in harmony with the claimed subject matter. 37 CFR 1.71. Finally, the cancellation of speculative statements does not in any way affect the scope of protection provided by the claimed subject matter in this or any other application. If applicant desires to further contest the propriety of the examiner's conclusion, or seek protection on the asserted utilities of the claimed compounds in this application which the examiner considered to be speculative, a continuing or divisional application can be filed to specifically claim the use of these compounds for the speculative utility.

Having enunciated the general Office policy to support the procedure followed by the examiner in this application, the application of this policy to the facts in this application will now be reviewed. The examiner has objected to assertions of utility of the claimed compounds as an antitumor agent in the

treatment of a w by malignant tu solid tumor (e.g. cancer). The ex these assertions face to those or view of the cont art.

Petitioner argu is not an incredib is routinely pro many cancer vici argued that the sound because th one shred of evid thought which made in the speci by working exam pounds from the on human myel 60," with testing to art recognized

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treatment of a warm-blooded animal afflicted by malignant tumors such as leukemia or solid tumor (e.g. digestive organ cancer, lung cancer). The examiner has concluded that these assertions are not believable on their face to those of ordinary skill in the art in view of the contemporary knowledge of the art.

Petitioner argues that cancer chemotherapy is not an incredible art because today's science is routinely providing life prolongation for many cancer victims. More specifically, it is argued that the examiner's position is unsound because the examiner has not provided one shred of evidence or one single reason or thought which controverts the assertions made in the specification which are supported by working examples with fourteen (14) compounds from the genus tested for their effect on human myelocytic leukemia cells "HL-60," with testing being conducted according to art recognized procedures.

In spite of the vast expenditure of human and capital resources in recent years, no one drug has been found which is effective in treating all types of cancer. Cancer is not a simple disease, nor is it even a single disease, but a complex of a multitude of different entities, each behaving in a different way (FDA Consumer, October 1977, pp. 18, 20, 21). While it may be clear, as petitioner argues, that workers in this art have shown that some cancers can be treated successfully in some patients, the effective treatment of various forms of malignant tumors remains a highly unpredictable art. In this respect, it is recognized that advances in the treatment of lung cancer have been few and modest. ("Advances in Cancer Treatment," American Druggist, August 1984 at page 51). However, if the art recognizes a nexus between the test results which applicants have conducted and a predictability of success for the specific uses that applicants have stated in the specification (page 7, lines 2-6: The present compound can be administered \* \* \* and can produce significant life-span prolonging effect.), or if the tests actually demonstrate success for the specific uses stated in the specification, then the statements are believable on their face to one of ordinary skill in this art and are a proper part of the description of the invention.

The examples described in Test 1 on pages 26 and 27 are considered to represent actual experimental results of in vitro tests demonstrating the "growth inhibiting effect" and "differentiation including activity" of several compounds in accordance with this invention against human myelocytic leukemia cells HL-60. Based on these reported test results, and in the absence of any in vivo data, would a person of ordinary skill in this art predict

with any reasonable degree of certainty, that the compounds would be useful as an antitumor agent to be administered to a warm-blooded animal afflicted by malignant tumors such as leukemia to produce significant life-span prolonging effect? I don't know, and the examiner has not provided any reason why that assertion would not be believable on its face. Consequently, on this record, where the assertion relates to an unclaimed utility, where it relates to the treatment of malignant tumors such as leukemia, and where the evidence of actual test results demonstrates some utility with leukemia cells, it was improper for the examiner to require cancellation of this part of the disclosure.

The examiner's requirement directed to "solid tumor (e.g. digestive organ cancer, lung cancer)" is considered sound. There is nothing in this record to suggest that a person of ordinary skill in this art would have any reason to predict that the compounds of this invention would be useful against solid tumors of the type named. The art of cancer therapy is still highly unpredictable. There is no evidence or even a bare assertion in this record that the tests reported in this specification are used for screening anti-cancer agents of potential utility in the treatment of such solid tumors. Additionally, there is no evidence that anti-cancer agents known to be useful in the treatment of malignant tumors such as leukemia would be expected to be useful in the treatment of solid malignant tumors such as digestive organ cancer or lung cancer.

[1] The examiner does not need to provide reasons why this speculative assertion should not be believed. The mere fact that the art of cancer chemotherapy is highly unpredictable places the burden on applicants to provide a basis for believing the speculative statements that they chose to place in the specification in the form of a positive assertion — "The present compound can be administered \* \* \* and can produce \* \* \*" The ignorance of the Patent and Trademark Office and applicants (in not being able to provide a scientific reason why the assertion is not sound) is not a sound reason or justification for permitting such an assertion to be made in a patent document where those of ordinary skill in this art would not accept it as believable on its face without some data or other evidence to support it. The Office does not want to spend the time or resources that may be necessary to provide a scientifically reasoned opinion as to why these speculative statements would not be believed by a person skilled in this art. Once more, it is counter productive for the PTO resources to be used doing research on matters that don't go to the validity of the

patent grant. However, the alternatives of permitting this journalistic liberty or involving the authority of the Commissioner under 21 USC § 372 are not attractive because they either betray the public trust or represent a further waste of government resources.

Accordingly, the examiner's requirement is clarified and modified to the following extent. Applicants are required under 35 USC § 132 to cancel that part of the specification disclosure at page 7, lines 4 and 5 which reads "or solid tumor (e.g. digestive organ cancer, lung cancer)," for the reasons given above. Failure to cancel this subject matter within the *TWO MONTH* shortened statutory period set for response to this action will be considered a failure to prosecute the application under 35 USC § 133. Applicants are reminded that the mere filing of a petition will not relieve applicants of the requirement to respond to this action. 37 CFR 1.181.

The petition is *GRANTED* to the extent indicated above. A modified requirement has been made, and a *TWO MONTH* shortened statutory period for response is set.

#### District Court, W.D. Virginia

Johnson v. University of Virginia

No. 84-0036-C

Decided Mar. 27, 1985

### COPYRIGHTS

#### 1. Infringement — In general (§24.201)

Copyright infringement action filed against state university is not barred by Eleventh Amendment, since 1976 Copyright Act, by prohibiting "anyone" from infringing on copyright, waived states' Eleventh Amendment immunity from liability for copyright infringement.

#### 2. Jurisdiction of courts — Copyrights (§43.20)

Possibility of connection between loss of copyright owner's photographic slides and defendant's alleged copyright infringement does not establish sufficient nexus between copyright owner's federal and state claims to warrant federal district court's exercise of pendent jurisdiction over plaintiff's state law claim.

### 3. Accounting — Damages — Copyrights (§11.253)

#### Costs — Attorney's fees (§25.5)

Alleged post-registration infringements which involve photographs that were first used by defendant prior to registration thereby "commenced" prior to registration and thus, pursuant to 17 USC 412, provide no basis for award of statutory damages or attorney's fees.

Action by David L. Johnson, against University of Virginia, et al., for copyright infringement and pendent state claim. On defendants' motions to dismiss and for summary judgment. Motions granted in part and denied in part.

John Di Joseph, Arlington, Va., for plaintiff.

John Gibney, Alexander Wellford, and David Kohler, all of Richmond, Va., for defendants.

#### Michael, District Judge.

This matter is before the court on defendants' motion to dismiss and motions for summary judgment. Plaintiff has alleged that defendants, the University of Virginia and two of its employees, infringed on plaintiff's copyrights for certain photographs taken at University of Virginia sporting events. Plaintiff has also alleged that defendants lost certain of plaintiff's photographic slides. In response to plaintiff's allegations, defendants argue that plaintiff's copyright claim is barred by the Eleventh Amendment of the United States Constitution, and plaintiff's pendent state claim for the lost photographic slides should be dismissed for lack of jurisdiction. Defendants also argue that plaintiff's claim for statutory damages and attorney's fees in connection with the alleged copyright infringement should be dismissed because plaintiff has not made the requisite showing for such damages and fees. The parties have submitted briefs and presented oral argument on these issues; therefore, defendants' motions are ripe for resolution by the court.

Defendants' Eleventh Amendment argument is premised on the principle that a claim seeking to impose a liability that must be paid out of a state's treasury is generally barred by the Eleventh Amendment. See, e.g., *Herer v. Burns*, 577 F.Supp. 762, 763 (W.D. Va.

1984). The court agrees with that plaintiff's copyright infringement derivatively is against the Commonwealth of Virginia, and thus seeks to in to be paid out of the Commonwealth. In addition, the court agrees that any Eleventh Amendment immunity enjoyed here by the Commonwealth be shared by defendants. The court believes that the Eleventh Amendment provides no immunity in that immunity was waived by Acts of 1909 and 1976.

The parties have noted the issue on whether the Copyright Act waived the states' Eleventh Amendment immunity from copyright infringement. *Wihtol v. Crow*, 309 F.2d 7185 (8th Cir. 1962) (holding Eleventh Amendment immunity waived by the 1909 Act); *Mill Arizona*, 591 F.2d 1278, 201 Cir. 1979) (holding that the Eleventh Amendment immunity was waived by the 1909 Act). The court is aware from any of the other Circuit Courts, or from the United States Supreme Court, concerning the effect of the states' Eleventh Amendment. Similarly, the court is aware from the United States Supreme Court of the Circuit Courts of Appeals of the effect of the Copyright Act on states' Eleventh Amendment immunity.

After carefully reviewing *Wihtol*, along with the parties' briefs, the court concludes that the Copyright Act of 1976, along with those cases, the court concludes that the Copyright Act of 1976 contains a more well thorough analysis of the Eleventh Amendment and the 1909 Act's effect on Eleventh Amendment immunity. *Wihtol* provides little more than a statement that the Eleventh Amendment suits against the states, their officers, and their agents acting in their official capacity, are barred by the Eleventh Amendment. 309 F.2d 7185.

The court notes that the *Wihtol* court was reluctant to find copyright infringement on the facts of the case. That court, it was faced by a "growing out of the unfortunate and seemingly harmless mistake" 309 F.2d at 780. Defendant was a high school music instructor who had copied plaintiff's copyrighted musical score and performed it in a school concert. Defendant, the choral school system received no money for the performance of the music. Following its characterization of the performance as "troublesome," the *Wihtol* court, however, reluctantly concluded that